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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,462	02/28/2002	Tomohiro Koyata	7217/66559	1812
530 7590 06/23/2009 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER LE, NANCY LOAN T				
ART UNIT 3621		PAPER NUMBER		
MAIL DATE 06/23/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/085,462

Applicant(s)

KOYATA ET AL.

Examiner

NANCY T. LE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009 and 13 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-8, 10, 11, 13, 16, 17 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-8, 10, 11, 13, 16, 17, 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action (mailed on *07 January 2009*) has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on *06 April 2009* has been entered.

Acknowledgements

All references to the capitalized versions of "Applicants" refer specifically to the Applicants of record. Any references to lower case versions of "applicant" or "applicants" refer to any or all patent "applicants". Unless expressly noted otherwise, references to "Examiner" refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.

This paper is given Paper No. 20090608 by the Examiner. This Paper No. is for reference purposes only.

Specification

The specification is objected to as failing to provide proper and antecedent basis for the claimed subject matter. See 37 C.F.R. 1.75(d)(1), MPEP § 608.01(o), and

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MPEP § 2181. The claims are replete with these errors, some example follow.

Correction of the following is required:

- a. The "*reference inquiry generating means* for generating reference inquiry information ..." as recited in claims 1 and 29.
- b. The "*inquiry result generating means* for generating a result of the inquiry ..." as recited in claim 1.
- c. The "*comparing means* for comparing the extracted particular sound frame of music data included in the inquiry information and the reference sound frame of music data, ..." as recited in claims 1 and 29.
- d. The "*discriminating means* for judging, based on the received result of the inquiry, whether the encoded digital data recorded on the storage medium is legally purchased data;" as recited in claims 1 and 29.

Status of Claims

Claims 1-3, 6-8, 10, 11, 13, 16, 17 and 29-33 have been examined and pending.

Claim Rejections - 35 USC § 112, 2nd Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-3, 6-8, 10, 11, 13, 16, 17 and 29-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

First, it is unclear as to what statutory class the “**information center**” recited in claims 1, 11 and 29 belong.

Second, claim elements:

- a. The “*reference inquiry generating means* for generating reference inquiry information ...” as recited in claims 1 and 29,
- b. The “*inquiry result generating means* for generating a result of the inquiry ...” as recited in claim 1,
- c. The “*comparing means* for comparing the extracted particular sound frame of music data included in the inquiry information and the reference sound frame of music data, ...” as recited in claims 1 and 29, and
- d. The “*discriminating means* for judging, based on the received result of the inquiry, whether the encoded digital data recorded on the storage medium is legally purchased data;” as recited in claims 1 and 29,

each is a **means (or step) plus function** limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function.

In these claims, the specification does not clearly link a corresponding structure to:

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- a. The “*reference inquiry generating means* for generating reference inquiry information ...” as recited in claims 1 and 29.
- b. The “*inquiry result generating means* for generating a result of the inquiry ...” as recited in claim 1.
- c. The “*comparing means* for comparing the extracted particular sound frame of music data included in the inquiry information and the reference sound frame of music data, ...” as recited in claims 1 and 29.
- d. The “*discriminating means* for judging, based on the received result of the inquiry, whether the encoded digital data recorded on the storage medium is legally purchased data;” as recited in claims 1 and 29.

Therefore, Applicant is required to:

- (a) Amend the claim so that the claim limitation will no longer be a **means** (or **step**) plus **function** limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

- (a) Amending the written description of the specification such that it **expressly** recites the corresponding structure, material, or acts for performing the claimed function

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and **clearly** links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

All other claims, i.e., claims 3, 6-8, 10, 13, 16, 17 and 30-33 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, by dependency.

Conclusion

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to NANCY LOAN T. LE whose telephone number is **(571) 272-7066**. The examiner can normally be reached on Monday - Friday, 9am - 6:00pm Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW J. FISCHER can be reached on **(571) 272-6779**.

For **official/regular communication**, the fax number for the organization where this application or proceeding is assigned is **(571) 273-8300**.

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For ***informal/draft communication***, the fax number is **(571) 273-7066 (Rightfax)**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197 (toll-free)**.

NANCY T. LE
Examiner, Art Unit 3621

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621